

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OSCAR E. AGAZZI, KENNETH W. CHURCH and WILLIAM A. GALE

Appeal No. 1997-0898
Application No. 08/281,879

ON BRIEF

Before KRASS, RUGGIERO, and GROSS, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 2-18, which are the only remaining claims in the present application. Claim 1 has been canceled. An amendment filed February 12, 1996 after final rejection has been entered.

The claimed invention relates to a method and apparatus for downsampling a document component where the component is in a text representation and has an associated reliability measure.

The reliability measure indicates the probability that the associated text representation correctly identifies the component. The component is downsampled by a first downsampling method if the reliability measure is above a threshold and by a second downsampling method if the reliability measure is below a threshold.

Claim 2 is illustrative of the invention and reads as follows:

2. A method of downsampling a document or a portion thereof comprising a set of one or more components, wherein each component in said set of one or more components is in a text representation and has an associated reliability measure, said reliability measure indicating the probability that the associated text representation correctly identifies said each component, the method comprising the steps of:

downsampling said each component by a first method of downsampling if said reliability measure is above a threshold; and

otherwise downsampling said each component by a second method of downsampling if said reliability measure is below said threshold.

The Examiner relies on the following prior art references:¹

Rao	5,359,671	Oct. 25, 1994
		(filed Mar. 31, 1992)

¹ In addition, the Examiner relies on the admitted prior art at pages 1 and 2 of Appellants' specification.

Appeal No.1997-0898
Application No. 08/281,879

Murdock et al. (Murdock) 5,418,864 May
23,
1995
(filed Jul. 11, 1994)

Claims 2-18 stand finally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the invention.

Claims 2-18 stand further finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Murdock in view of the admitted prior art (hereinafter APA) with respect to claims 2, 3, 5-8, 10, 12-14, 16, and 17, and adds Rao to the basic combination with respect to claims 4, 9, 11, 15, and 18.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of obviousness relied

² The Appeal Brief was filed June 21, 1996 (Paper no. 18). In response to the Examiner's Answer dated September 6, 1996 (Paper No. 19), a Reply Brief was filed November 12, 1996 (Paper No. 21) , which was acknowledged and entered by the Examiner as indicated in the communication dated January 31, 1997 (Paper No. 22).

upon by the Examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the claims particularly point out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph. We are also of the conclusion that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the appealed claims 2-18. Accordingly, we reverse.

We consider first the Examiner's indefiniteness rejection of claims 2-18 under the second paragraph of 35 U.S.C. § 112. The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language

depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification.

Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

After reviewing the arguments of record, we are in agreement with Appellants (Brief, page 4; Reply Brief, pages 1-3) that, contrary to the Examiner's assertion, there is no ambiguity or lack of clarity in the claimed terminology "threshold," especially in view of Appellants' description at page 6 of the specification. Similarly, we find no ambiguity in the language "...a reliability measure based on the degree of similarity between the text representations of components" appearing in claims 4, 9, 11, 15, and 18. As pointed out by Appellants, the specification at pages 7 and 8 describes how a reliability measure is generated based on a degree of similarity such as by a measure of Hamming distance. It is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of the invention recited in the appealed claims. Therefore, the Examiner's rejection under the second paragraph of 35 U.S.C. § 112 is not sustained.

We next consider the Examiner's obviousness rejection of claims 2, 3, 5-8, 10, 12-14, 16, and 17 based on the combination of APA and Murdock. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

Appeal No.1997-0898
Application No. 08/281,879

1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.
825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,
776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.
denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v.
Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933
(Fed.

Cir. 1984). These showings by the Examiner are an essential
part

of complying with the burden of presenting a prima facie case of
obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d
1443, 1444 (Fed. Cir. 1992).

Appellants' response (Brief, pages 5-7) to the Examiner's
obviousness rejection asserts the Examiner's failure to set
forth a prima facie case of obviousness since proper motivation
for the proposed combination of references has not been
established. In particular, Appellants contend that nothing in
the Murdock reference suggests any desirability of using
different downsampling techniques dependent on a reliability
measure, a feature present in all of the independent claims on
appeal.

After careful review of applied prior art references in light of the arguments of record, we are in agreement with Appellants' position as stated in the Briefs. As asserted by Appellants, Murdock is not concerned with techniques of downsampling but, rather, with a method that provides a determination of the image of a particular component based on the output of each optical character recognition system in a set of character recognition systems. We find no compelling reason offered by the Examiner for the skilled artisan to look to Murdock to solve the downsampling problem suggested by APA. In our view, any suggestion to make the Examiner's proposed combination does not come from the references themselves but instead from Appellants' own disclosure. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is also apparent to us from the Examiner's line of reasoning in the Answer that, since the Examiner has mistakenly interpreted the disclosure of Murdock, the issue of the

obviousness of adding a reliability measure to determine which of the two downsampling techniques disclosed by APA is to be selected has not been addressed. Since all of the claim limitations are not taught or suggested by the applied prior art, it is our opinion that the Examiner has not established a prima facie case of obviousness with respect to independent claims 2, 7, 10, 13, and 16. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of independent claims 2, 7, 10, 13, 16 nor of claims 3, 5, 6, 8, 12, 14, and 17 dependent thereon, based on the combination of APA and Murdock.

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejection of dependent claims 4, 9, 11, 15, and 18 in which the Rao reference is added to the combination of APA and Murdock, we do not sustain this rejection as well. It is apparent from the Examiner's analysis (Answer, page 7) that the Rao reference is relied on solely to address the claimed clustering and distance measure limitations. We find nothing, however, in the disclosures of Rao which would overcome the innate deficiencies of APA and Murdock discussed supra.

Appeal No.1997-0898
Application No. 08/281,879

In summary, we have not sustained either of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 2-18 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

Appeal No.1997-0898
Application No. 08/281,879

JFR/lp

Appeal No.1997-0898
Application No. 08/281,879

S H DWORETSKY
AT&T BELL LABORATORIES
600 MOUNTAIN AVENUE
P O BOX 636
MURRAY HILL NJ 07974-0636

Lettie

JUDGE RUGGIERO

APPEAL NO. 1999-0898

APPLICATION NO. 09/281,879

APJ RUGGIERO

APJ KRASS

APJ GROSS

DECISION: **REVERSED**

PREPARED: Jun 24, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK